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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,156	02/08/2001	Ursula Murschall	00/053 MFE	4234

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EXAMINER
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FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/779,156

Applicant(s)

MURSCHALL ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment, mailed September 15, 2005.

Claim 21 was cancelled rendering claims 1-11 and 16-20 pending.

The indicated allowability of claims 1-11 and 16-20 is withdrawn in view of the newly discovered reference(s) to Murschall et al (U.S. 6,939,600). Rejections based on the newly cited reference(s) follow.

### ***Obvious Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-11 and 16-20 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13, 16 and 18-19 of U.S. Patent No. 6,939,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both include an opaque, white film with a thickness of from 10 to 500 $\mu$ m, wherein the film comprises thermoplastic, polyester, barium sulfate, optical brightener and modulus of elasticity in the transverse direction of greater than equal to 4,200 N/mm<sup>2</sup>. Although U.S. 6,939,600, does not explicitly teach the film comprises a pigment, the barium sulfate in the reference functions as the pigment, as disclosed in claim 3 of the instantly claimed application.

***Claim Rejections – 35 USC § 103(a)***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 5,660,931) in view of Peiffer et al. (U.S. 6,641,924).

Kim shows a white film (base layer) comprising polyethylene terephthalate (a thermoplastic), comprising barium sulfate (column 1, line 61 through column 2, line 9), and bisbenzoazole (optical brightener) (column 5, lines 13-22) where white film has a thickness of 12 $\mu$ m (column 9, lines 11-16). Kim shows that the film may comprise

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additives (column 6, lines 59-65) and has a functional coating (column 5, lines 18-40 and column 6, lines 25-28). The reference shows the film comprises polyester and imparts whiteness and hiding power (opacity) (column 2, lines 22-28). The phrases "wherein the barium sulfate or the optical brightener. . . have been incorporated directly into the thermoplastic or fed as a masterbatch during film production" introduces process limitations to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. MPEP 2113. Further, process limitations are given no patentable weight in product claims. Kim does not teach the white film comprising regrind.

Peiffer teaches an opaque white polyester film comprising regenerated material (regrind) in an amount of from about 10 to 70% by weight (column 2, line 62 through column 3, line 4 and claims 1, 8 and 9) comprising thermoplastic polyester (column 4, lines 43-44) and antiblocking agents such as barium sulfate (column 8, lines 31-35). Kim and Peiffer are analogous art as they are both directed to white films. It would have been obvious to one of ordinary skill in the art to include regrind in the film of Kim because Peiffer teaches using regenerated material decreases the cost of the film and does not have any negative effect on the physical property of the film (column 2, line 62 through column 3, line 4). The opaque white film of Kim in view of Peiffer would be expected to have lower luminous transmittance than a comparable film because it

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comprises regrind similar to the claimed film, which would result in a lower luminous transmittance than comparable films, absent any evidence to the contrary.

6. Claims 1-11 and 17-20 are allowed. The closest prior art does not teach or suggest the recited opaque, white film further including a modulus of elasticity in the transverse direction of greater or equal to  $4200 \text{ N/mm}^2$ . Additionally, the closest prior art does not teach or suggest the recited opaque, white film further including a modulus of elasticity in the machine direction of at least  $3300 \text{ N/mm}^2$  and in the traverse direction of greater than or equal to  $4200 \text{ N/mm}^2$ ; tear strengths in the machine direction of greater than or equal to  $120 \text{ N/mm}^2$  and in the traverse direction of greater than or equal to  $170 \text{ N/mm}^2$  and elongations at break of greater than or equal to 120% in the machine direction and greater than or equal to 50% in the traverse direction. The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

### ***Response to Arguments***

7. Kim (U.S. 4,933,043) in view of von Meer (U.S. 4,384,040) is withdrawn due to Applicant canceling claim 21.

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**Conclusion**


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson  
Patent Examiner  
AU 1774



RENA DYE  
SUPERVISORY PATENT EXAMINER

A.U. 1774 11/24/05